

REMARKS

In the Office Action dated January 29, 2004, claims 8 and 28 were objected to; claims 1-10 were rejected under 35 U.S.C. § 103 over U.S. Patent No. 6,145,088 (Stevens) in view of U.S. Patent No. 6,195,695 (Cheston); claims 11 and 31 were rejected under § 103 over Stevens in view of Cheston and U.S. Patent No. 5,469,573 (McGill); claim 30 was rejected under § 103 over Stevens in view of Cheston and U.S. Patent No. 6,374,366 (Maffezzoni); claims 12-16 and 18-20 were rejected under § 103 over Stevens in view of McGill; claims 24-26 were rejected under § 103 over Stevens in view of McGill and Maffezzoni; claims 17 and 21-23 were rejected under § 103 over Stevens in view of Maffezzoni; claims 27 and 28 were rejected under § 103 over Stevens in view of Maffezzoni and McGill; and claim 29 was rejected under § 103 in view of Stevens in view of Maffezzoni and McGill.

Claims 8 and 28 have been amended to address the objections.

Claim 1 is not obvious over the asserted combination of Stevens and Cheston.

It is respectfully submitted that there is no motivation or suggestion to combine the teachings of Stevens and Cheston. Cheston *explicitly teaches away* from the combination of Stevens and Cheston in the manner proposed by the Office Action. Stevens proposes a fault recovery mechanism that involves the local storage of two copies of an application and operating system. If the working copy of the application and operating system is defective, then the backup copy of the application operating system is used in the system. As noted in Cheston, the recovery from corrupted application and operating system is performed *without having to download a new copy of the executable application and operating system using some of the limited communication channel capacity* in the process. Cheston, 2:16-23. Cheston states that obtaining a copy of the application program and operating system from a server after the application and operating system have become corrupted and crashed *consumes communication resources and bandwidth*, which was noted as a disadvantage and limitation of prior art systems. Cheston, 1:47-50. Cheston further states that “it would be desirable to avoid extra communications that would be involved in downloading another copy of the executable application (and operating system).” Cheston, 1:61-63. Thus, Cheston is explicitly clear in teaching that it is not desirable to access a network in response to a

failure. This teaching directly contradicts the teachings of Stevens and the subject matter of claim 1. Stevens teaches the use of a network to download data from a remote data recovery facility. The teachings of Stevens and Cheston are at odds with each other, and therefore, a person of ordinary skill in the art would not have been motivated to combine Stevens and Cheston in the manner proposed by the Office Action. As stated by the MPEP, where references teach away from their combination or the claimed invention, there can be no suggestion or motivation to combine. *See* MPEP § 2145 (8<sup>th</sup> ed., Rev. 1) at 2100-156.

As stated by the MPEP, "prior art must be considered in its entirety, including disclosures that teach away from the claims." *Id.* "It is improper to combine references when the references teach away from their combination." *Id.* at 2100-157. In the Examiner's response to Applicant's previous arguments, the Examiner stated that "the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references." 1/29/2004 Office Action at 26. Applicant did not make the above argument. Rather, Applicant is specifically pointing to the explicit teachings of the references that teach away from the combination of Stevens and Cheston. In rendering the obviousness rejection of claim 1, the Office Action ignored the most pertinent sections of Cheston. Applicant respectfully submits that pertinent teachings of a reference cannot be ignored, as a reference must be considered in its entirety. Because Cheston teaches away from the combination of references and away from the claimed invention, it is respectfully submitted that claim 1 is not obvious over the asserted combination of Stevens and Cheston.

Also, the hypothetical combination of Stevens and Cheston does not teach or suggest every element of claim 1. The Office Action conceded that Stevens does not disclose a storage element containing a flag to indicate if a fault has occurred with a first operational element, and a backup device to enable access of the network through an interface in response to the flag indicating failure of the first operational element. The Office Action pointed to elements 55 and 60 in Figure 2 of Cheston as teaching a storage element containing such a flag. However, that is simply not the case, as element 55 of Figure 2 refers to testing to determine whether the working copy of the application and

operating system is corrupted, and if so, to make the backup copy the working copy and to make another copy (a third copy) the backup copy (at block 60). Cheston, 4:17-49. There is no indication within Cheston of a storage element containing a flag to indicate if a fault has occurred with a first operational element, *and* a backup device to enable access of a network through an interface in response to the flag indicating failure of the first operational element.

Stevens fails to disclose a backup device to enable access of a network through an interface *in response to the flag indicating failure* of the first operational element.

Cheston specifically teaches that it is undesirable to access a network to copy an executable application and operating system in response to failure. Therefore, neither reference teaches or suggests a backup device to enable access of a network through an interface in response to a flag indicating failure of the first operational element.

Therefore, even if they can be combined, the hypothetical combination of Stevens and Cheston does not teach or suggest each and every element of claim 1.

Claims dependent from claim 1 are allowable for at least the same reasons as for claim 1.

Because base claim 1 is allowable over the asserted combination of Stevens and Cheston, it is respectfully submitted that the obviousness rejection of claim 11 (which depends from claim 1) over Stevens, Cheston, and McGill is defective and should be withdrawn. Also, the obviousness rejection of claim 30, which depends from claim 1, over Stevens, Cheston, and Maffezzoni is also defective and should be withdrawn.

Moreover, claim 5, which depends from claim 3, which in turn depends from claim 1, recites that the first operational element comprises a first disk drive, and the backup storage element comprises a second disk drive *separate* from the first disk drive. Cheston also teaches away from this aspect of the claimed invention. Cheston explicitly teaches that providing separate physical media for storing an uncorrupted copy of an executable application and operating system is undesirable due to cost and security reasons. Cheston, 1:66-2:9. Because Cheston teaches away from the claimed invention, there can be no suggestion or motivation to combine Stevens and Cheston to achieve the claimed subject matter. *See* MPEP § 2145 at 2100-156 ("A prior art reference that

'teaches away' from the claimed invention is a significant factor to be considered in determining obviousness.").

Independent claim 12 was rejected over the asserted combination of Stevens and McGill. The Office Action conceded that Stevens does not disclose that the retrieved data comprises an image containing user data and an operating system, and recovering the system using the image. However, the Office Action cited to McGill as teaching this feature. Applicant respectfully disagrees, as McGill also teaches away from retrieving an image containing user data and an operating system, and recovering the system using the image. McGill describes the backing up of files to backup tape, and using a recovery program to recover operating system files to enable a computer to be rebooted from the recovered operating system files. However, note that McGill contemplates a multi-step process in which operating system files, system configuration files, and device drivers are loaded into a computer so that booting of the computer can occur from the recovered operating system files before other data files (such as user data) can be loaded. It is after booting from the restored operating system files that the hard drive can be further restored from the backup tape. McGill, 6:26-33. McGill explicitly teaches that the tape backup program should be capable of backing up the entire system "in a manner where individual data files can be retrieved from the backup media and restored to the hard drive, rather than requiring a restoration of the entire image of the hard drive." McGill, 5:24-28. Thus, McGill explicitly teaches the undesirability of restoring a system from an image--instead, McGill teaches a multi-step process where important files, such as operating system files, system configuration files, and device drivers are first loaded from the backup tape, so that a computer can be rebooted, followed by restoring the rest of the hard drive from the backup tape if necessary. McGill, 6:32-33.

Therefore, there is no suggestion or motivation to combine Stevens and McGill, as McGill teaches away from the claimed combination and claimed invention. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 12 over Stevens and McGill.

Moreover, even if the references can be combined, Stevens and McGill does not disclose or suggest the recovering act of claim 12. As conceded by the Office Action, Stevens does not disclose recovering the system using the image containing user data and

an operating system. As noted above, McGill also does not disclose or suggest recovering a system using an image containing user data and an operating system. Rather, McGill teaches that the recovery of a hard drive is performed in discrete steps, with operating system files and other configuration files first loaded to enable booting of the system, followed by restoration of the rest of the hard drive from the backup tape. Recovering a system using *an* image is not performed by McGill. Therefore, the hypothetical combination of Stevens and McGill fails to disclose or suggest recovering a system using an image containing user data and operating system.

Independent claim 18 is similarly allowable over the asserted combination of Stevens and McGill.

Claims dependent from independent claims 12 and 18 are allowable for at least the same reasons as the corresponding independent claims.

Claims 24-26 (which depend directly or indirectly from claim 12) were rejected as being obvious over Stevens, McGill, and Maffezzoni. In view of the fact that the obviousness rejection of base claim 12 is defective, it is respectfully submitted that the obviousness rejection of claims 24-26 over Stevens, McGill, and Maffezzoni is also defective. Withdrawal of the rejection of claims 24-26 is respectfully requested.

Independent claims 17 and 21 have been cancelled (without prejudice) to render the rejection of those claims moot. Claims 27 and 29 have been amended from dependent form to independent form. Each of claims 27 and 29 was rejected over the asserted combination of Stevens, Maffezzoni, and McGill. As described above in connection with claim 12, McGill teaches away from retrieving image data containing user data and an operating system to recover a system. As taught explicitly by McGill, a tape backup program should be capable of backing up the entire system "in a manner where individual data files can be retrieved from the backup media and restored to the hard drive, rather than requiring a restoration of the entire image of the hard drive." McGill, 5:24-28. Thus, McGill explicitly teaches the undesirability of restoring a system from an image. Therefore, a person of ordinary skill in the art would not have been motivated to combine McGill with Stevens and Maffezzoni. Thus, a *prima facie* case of obviousness has not been established with respect to claim 27 for at least this reason.

Moreover, none of the three references (Stevens, Maffezzoni, and McGill) teaches or even remotely suggests the following feature of claim 27: storing retrieved image containing user data and operating system software in portions of the storage device other than the portions that are identified to be defective by the scan. Although Maffezzoni describes performing a media scan of a hard drive and mapping out bad sectors, Maffezzoni does not teach or suggest storing retrieved image data containing user data and operating system software in portions of a storage device other than the portions identified to be defective by a scan. This feature is also completely lacking in Stevens and Maffezzoni.

Thus, the hypothetical combination of Stevens, Maffezzoni, and McGill does not teach or suggest all elements of claim 27.

Independent claim 29 is allowable over Stevens, Maffezzoni, and McGill for similar reasons as for claim 27. Independent claim 28, which depends from claim 27, is allowable over the cited references for at least the same reasons as claim 27.

In view of the foregoing, all claims are in condition for allowance, which action is respectfully requested. The Commissioner is authorized to charge any additional fees, including extension of time fees, and/or credit any overpayment to Deposit Account No. 20-1504 (MCT.0133US).

Respectfully submitted,

Date: \_\_\_\_\_

4-29-04



Dan C. Hu, Reg. No. 40,025  
TROP, PRUNER & HU, P.C.  
8554 Katy Freeway, Suite 100  
Houston, TX 77024  
713/468-8880 [Ph]  
713/468-8883 [Fax]